

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

The claims have not currently been amended.

Declaration Under 37 C.F.R. § 1.131

Initially, it is respectfully noted that the submission filed on December 27, 2004 constituted a “Declaration” and not an “affidavit” as alluded to in the Official Action. As such, that document will be addressed as a “Declaration” for all future references to that document.

Submitted herewith is a Supplemental Declaration under 37 C.F.R. § 1.131 (hereinafter “Supplemental Declaration”) by the inventor, Craig M. Wittenbrink (hereinafter “Applicant”). The Supplemental Declaration is being submitted to better comply with all of the provisions of 37 C.F.R. § 1.131. In addition, the Supplemental Declaration overcomes the objections asserted against the Declaration under 37 C.F.R. § 1.131 filed by the Applicant, on December 27, 2004.

For instance, paragraph 3 of the Supplemental Declaration states that the Applicant “conceived, reduced to practice, and had possession of the subject matter of the invention claimed in the patent application identified above (hereinafter “Claimed Invention”) while an employee at the Hewlett-Packard Laboratories in Palo Alto, California, USA.” Accordingly, the Examiner is respectfully requested to withdraw the indication that the Declaration is ineffective for failing to be properly executed.

Paragraph 4 of the Supplemental Declaration states that the documents attached to the Supplemental Declaration “are incorporated to and form part of the present Declaration in

their entireties.” As such, the Examiner is respectfully requested to withdraw the indication that the Declaration fails to comply with the requirement that exhibits form part of the declaration.

Paragraph 5 of the Supplemental Declaration indicates how the claims of the present invention correlate with the disclosure contained in the “True Transparency with the Fragment Buffer Graphics Architecture” document (hereinafter “True Transparency Article”) that was submitted with an invention disclosure document by the Applicant. Accordingly, the Examiner is respectfully requested to withdraw the indication that the Declaration contains only conclusory statements.

Actual Reduction to Practice

The Official Action asserts that the documents submitted with the Declaration on December 27, 2004 fail to constitute an actual reduction to practice. It is respectfully submitted, however, that the attached Supplemental Declaration shows with sufficient detail to enable the Examiner to determine that the claimed invention was actually reduced to practice on or before November 11, 1999.

Paragraph 5 of the Supplemental Declaration shows which claimed elements correspond with which sections in the True Transparency Article. In addition, section 5.1 of the True Transparency Article discusses the various test conditions as well as pseudo-code for a working model of the claimed invention. Moreover, section 6 of the True Transparency Article concludes that “[a] simulation was developed for the best fit for a traditional Z buffering architecture”, that “the detailed hardware architecture, and control logic were presented” in the paper, that “[s]imulation results were shown, as partial validation of the design with several models”, and that “[t]he fragment buffer can provide true transparency

with additional off chip DRAM storage, used in combination with new comparison, control, and compositing logic.”

The indications in the True Transparency Article that simulations were run successfully is clear evidence that the claimed invention was reduced to practice. *See, e.g., Corona v. Dovan*, 273 U.S. 692, 1928 C.D. 252 (1928)(“A process is reduced to practice when it is successfully performed. A manufacture [i.e., article of manufacture] is reduced to practice when it is completely manufactured.”). In addition, the Applicant recognized and appreciated the invention as evidence by his conclusion that the simulations were run successfully and that “the fragment buffer can provide true transparency”.

The Supplemental Declaration therefore clearly shows that models corresponding to the claimed invention were disclosed in the True Transparency Article, such as those defined in the pseudo-code listed in section 5.1, and that these models produced successful results. Accordingly, the True Transparency Article is clear evidence that the Applicant actually reduced the claimed invention to practice as early as November 11, 1999.

Constructive Reduction to Practice

Also submitted herewith is a Declaration of Attorney under 37 C.F.R. § 1.131 (hereinafter “Attorney Declaration”) filed by the attorney, Marc P. Schuyler (hereinafter “Attorney”), who drafted and filed the above-identified patent application. As stated in the Attorney Declaration, the claimed invention was conceived of as early as November 11, 1999. In addition, the attorney worked reasonably diligently to prepare and file the above-identified application in light of his pending workload during the critical period.

As stated in MPEP 2138.06, “[t]he critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to

the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice.” Citing to *Hull v. Davenport*, 90 F.2d 103, 105, 33 USPQ 506, 508 (CCPA 1937). The critical period for which diligence must be shown in this case is therefore between just before July 19, 2000 and June 14, 2001.

As also stated in MPEP 2138.06, “[r]easonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.” *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986). The Attorney practiced reasonable diligence in preparing and filing the above-identified patent application during the critical period in compliance with this requirement, as discussed in the Attorney Declaration.

The Attorney Declaration therefore clearly shows that the inventor conceived of the claimed invention at least as early as November 11, 1999 and that the Attorney practiced reasonable diligence during the critical period until June 14, 2001. Accordingly, the Examiner is respectfully requested to accept the Attorney Declaration as evidence that the above-identified application should be afforded priority back to November 11, 1999.

Claim Rejections Under 35 U.S.C. §102(e)

The Official Action sets forth a rejection of Claims 1, 2, 4-12, and 14-22 under 35 U.S.C. §102(e) as allegedly being anticipated by the disclosure contained in U.S. Patent No. 6,670,955 issued to Morein (hereinafter “Morein Patent”). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

As shown by the Supplemental Declaration and the Attorney Declaration submitted herewith, the Morein Patent cannot be considered as “prior art” over the present invention. More particularly, the Supplemental Declaration shows that the present invention was actually reduced to practiced prior to the filing date of the Morein Patent. In addition, the Attorney Declaration shows that the present invention was conceived and constructively reduced to practice, with reasonable diligence performed during the critical period, such that the present invention should be afforded priority back to November 11, 1999. Accordingly, because the Applicant invented the subject matter of the present application prior to July 19, 2000, the Morein Patent does not qualify as prior art under 35 U.S.C. §102(e).

For at least these reasons, the Examiner is respectfully requested to withdraw the rejection of Claims 1, 2, 4-12, and 14-22 and to allow these claims.

Claim Rejections Under 35 U.S.C. §103

The Official Action sets forth a rejection of Claims 3 and 13 under 35 U.S.C. §103(a) as allegedly being unpatentable over the disclosure contained in the Morein Patent in view of Schilling, “A New Simple and Efficient Antialiasing with Subpixel Masks” (hereinafter “Schilling Article”). Applicant respectfully requests reconsideration of this rejection for at least the following reasons.

The Schilling Article has apparently been cited merely for the purpose of asserting that subpixel masks are generally known in rendering processes. It is respectfully submitted that removal of the Morein Patent from the pool of available art requires withdrawal of this rejection. That is, an obviousness rejection cannot be based on the Schilling Article alone and the allegation that subpixel masks are generally known in the field of rendering is insufficient to render Claims 3 and 13 unpatentable.

PATENT

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Accordingly, the Examiner is respectfully requested to withdraw the rejection of Claims 3 and 13 and to allow these claims.

Conclusion

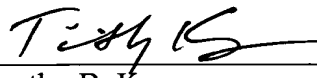
In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited.

Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to deposit account no. 08-2025.

Respectfully submitted,

Dated: November 22, 2005

By



Timothy B. Kang
Registration No. 46,423

MANNAVA & KANG, P.C.
8221 Old Courthouse Road
Suite 104
Vienna, VA 22182
(703) 652-3817
(703) 880-5270 (fax)